

## **REMARKS**

### **I. Introduction/Amendment**

Claims 1-36 and 41 are presently are pending, and claims 37-40 were previously withdrawn from consideration.

Each of independent Claims 1, 17, and 27 has been amended to reflect that the dead bank card is a dead deposit card for an inactive deposit account “comprising a checking account or a savings account.” Applicant regards this as already being inherent in the claims, as the dead bank card was already recited as being “associated with an inactive deposit account.” Applicant regards “dead deposit cards” as recited in the amended claims as encompassing (dead) debit cards, check cards, and ATM cards, but not credit cards or charge cards.

Applicant has also amended the independent claims to clarify that the unsolicited dead bank cards are distributed “from the issuing bank to the customer/person”. Support is found in at least par. [0010], [0012], and [0076] of the published application.

### **II. Double Patenting Rejection**

Claims 1, 15-17, 23 and 27-36 are provisionally rejected under non-statutory obviousness-type double patenting grounds over claims 41-42, 45-51, 57-58, 62, and 73-75 of US Patent Application 11/780,930. See Office Action at 2.

Applicant attaches hereto a Conditional Terminal Disclaimer to be entered upon allowance of claims from this application. This Conditional Terminal Disclaimer shall apply only if US Patent Application 11/780,930 issues as a patent in the future. Applicant requests that the Examiner withdraw the provisional double patenting rejection.

### **III. Rejections Under 35 U.S.C. § 103**

The Examiner's rejections have been based on the position that:

"Nonobviousness cannot be established by attacking the references individually, when the rejection is predicated upon a combination of prior art disclosures. See *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir.1986). The applicant has attacked the references individually, when rejection was made using a combination of Melchione et al., Walker et al., Nabe et al. and Strock et al."

11/26/10 Nonfinal Office Action at 20. Applicant respectfully traverses the characterization of how Applicant has distinguished the cited art, as well as the legal proposition (purported holding) for which *In re Merck* is cited.

Applicant did not merely "attack[] the references individually". Applicant has showed the individual references fail to teach or suggest certain claim limitations, and has further showed that the combination offered by the Examiner fails to teach or suggest certain claim limitations. Applicant also notes that if the Examiner is combining references without further modification justified by another reference or ordinary design skill, then a showing that none of the references alone teaches or suggests a claim limitation does, in fact, defeat the combination. This is because, in such a rejection, the combination cannot supply an element that is missing from every reference in the combination.

It is well-established that a *prima facie* obviousness rejection must address the invention as a whole including all claim limitations. *KSR Intern. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 1740 (2007) (inquiry based on "the subject matter as a whole", "claimed subject matter"); *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970) ("All words in a claim must be considered in judging the patentability of that claim against the prior art."). It follows from the invention-as-a-whole rule that an obviousness rejection based on a combination of references must teach or fairly suggest each of the claim limitations.

The Examiner cites *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir.1986), for the proposition that an obviousness rejection based on a combination of references cannot be defeated by showing that a claim element is missing from each of the references individually. 11/26/10 Nonfinal Office Action at 20 (citing *In re Merk* for the legal proposition that “nonobviousness cannot be established by attacking the references individually, when the rejection is predicated upon a combination of prior art disclosures.” The *Merck* case does not support that broad proposition at all.

In *Merk*, the issue was whether the use of drug A for treatment of depression was obvious in view of drug B used for depression. Several references were cited by the examiner to show the known similarities in structure and properties between claimed drug A and known drug B. *Id.* at 1096. The portion of *In re Merk* cited by the Examiner related to an argument by the applicant that a single reference taught away from the claimed invention. *Id.* at 1097 (“We also find untenable appellant’s arguments that Petersen [relating to drug B] teaches away from appellant’s invention. Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references.”). *Merk* is inapplicable here where the argument the Examiner rejects is not that a particular reference teaches away—instead, the issue here is the cited art fails to disclose certain claim elements.<sup>1</sup> Moreover, *Merk*’s holding was based on the applicant’s focusing only on a single reference—here Applicant has done what the appellant in *Merk* did not, which is examine all of the cited references for their teachings. The most that can be fairly taken from *Merk* is that an

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<sup>1</sup> Based on a Westlaw search, *Merk* has not been cited to or relied on in any published decision of the Federal Circuit or any District Court as authority for this issue.

attack on a combination of references should not be limited to analyzing a single reference, rather, it should include an analysis of what each of the references teaches. That is precisely what Applicant has done here in showing that every one of the cited references fails to teach or suggest certain limitations of the invention.

**A. Claims 1-22, 24-26, and 41 Are Patentable Over the Five-Part Combination of Melchione + Walker + Richards + Jones + Nabe**

Claims 1-22, 24-26, and 41 stand rejected under 35 U.S.C. § 103 as rendered obvious by the 5-part combination of:

- (1) Melchione (US Pat. No. 5,930,764) in view of
- (2) Walker (US Pub. No. 2008/0052225), further in view of
- (3) Richards, B., "Beware the Arrival of Unsolicited Debit Cards (Madison Capital Times: 2000), further in view of
- (4) Jones (US Pub. No. 2004/0117300), and further in view of
- (5) Nabe (US Patent No. 7,305,364).

Office Action at 2. Applicant respectfully submits that the combination of these five references does not render the claimed invention obvious. Applicant shall first analyze the combination with regards to Claim 1.

**1. “Identifying . . . a pool of potential new bank deposit account holders for a bank [and] determining . . . if a person from the pool is an existing bank deposit account holder”**

According to Claim 1, dead bank cards may be distributed in an unsolicited manner based on “identifying . . . a pool of potential new bank deposit account holders [and] determining . . . if a person from the pool is an existing bank deposit account holder.”

**Melchione**

The primary reference, Melchione, describes a sales lead generation system for marketing campaigns that is based on a central database with information on all bank customers called the CCIS (Central Customer Information System). Melchione, Abstract; Figure 1; Summary, Col. 5-7 (e.g., “the central database serves as a single repository for storing all customer related information throughout the business”; “central database . . . is a comprehensive and enriched database that includes information about all customers and products in the financial institution”). Using the central customer database, sales leads are generated and then administered (marketed) through dedicated stations called micro-marketing centers. Melchione, Abstract; Figure 1.

Melchione does not teach or suggest “identifying . . . a pool of potential new bank deposit account holders [and] determining . . . if a person from the pool is an existing bank deposit account holder.” At best, Melchione teaches a general system of marketing based on customer information in a database. Nowhere does Melchione disclose (1) creating a pool of potential new deposit account holders and then (2) determining if a person from the pool is an existing bank deposit account holder. For example, Figure 5 of Melchione shows a flowchart for generating lists of leads based on the central customer database. Figure 5 does not teach or suggest generating a pool of potential bank deposit account holders and then determining if a person from the pool is an existing bank deposit account holder.

At page 3 of the Office Action, the Examiner cites to Melchione at Figure 1; Col. 1, lines 1-29; and Col. 27, lines 32-43, 41-48 as disclosing this claim limitation. However, Figure 1 merely “is a high level view of the sales and service support system of the present invention”. Figure 1 does not remotely disclose the claim limitation at issue. Column 1, lines 1-29 of Melchione sets forth the Field of the Invention:

“The present invention relates generally to a sales and service support system and method, and in particular, to an electronic sales and service support system and method for assisting customer service and identifying sales targets, distributing sales leads, enhancing sales tools, and tracking performance of sales and sales personnel.”

That passage does not remotely disclose the claim limitation of “identifying . . . a pool of potential new bank deposit account holders [and] determining . . . if a person from the pool is an existing bank deposit account holder.”

The other passage cited by the Examiner describes a generic, searchable database of customer information for generating leads:

“A plurality of micromarketing workstations 12 preferably make up the micro marketing center 11 for responding to requests from branch managers for lists of leads for selected sales programs. The sales programs typically involve a marketing campaign for new or existing products or services offered by the financial institution. The micro marketing center 11 works with the branch managers to determine the profile of households, customers, and/or accounts most likely to purchase the products or services of the sales campaign. The micro marketing center then constructs a specific query, runs the query against the central database, and generates a report containing an optimum list of leads for each marketing campaign. The workstation at the micro marketing center provides means for searching the central database 10 and extracting a list of all households, customers, or accounts that meet a specific selection criteria. The list of leads are then used to target a direct mailing to the customers or households that meet the specific selection criteria for the sales campaign, or the list of leads is sent directly to the CCIS 13.”

Melchione, Col. 27, lines 29-48. That passage does not remotely disclose the claim limitation of “identifying . . . a pool of potential new bank deposit account holders [and] determining . . . if a person from the pool is an existing bank deposit account holder.”

The Examiner also references Figure 13A in connection with this claim limitation. Office Action at 3. According to Melchione, Figures 13A-M “are a flow chart showing the preferred process for performing the step of building an account in the method.” Thus, these figures are directed to building a new account, not identifying a pool of potential new bank deposit account holders and determining if a person is an existing bank deposit account holder, as claimed.

#### **Other References**

The other references relied on by the Office Action do not teach or suggest this claim limitation. Walker teaches the offer of an a preapproved unsolicited credit card by a sponsoring organization (e.g., casino) based on the expected arrival time of a consumer at the sponsor's location (checking in at the casino). Walker, Abstract; Figs. 5A-5C. Richards discloses a consumer advocate's complaint about an unsolicited debit card being improperly sent for an existing, active deposit account. Jones teaches a solicited dual card having a private label credit card (PLCC) account for the merchant and a general-use bank credit card account. Jones, Abstract; Fig. 2B. Nabe teaches a customer lead generating system for dealers selling products like replacement auto loans. Nabe, Abstract; Fig. 3.

None of the above references teaches or suggests “identifying . . . a pool of potential new bank deposit account holders [and] determining . . . if a person from the pool is an existing bank deposit account holder.”

**2. “Unsolicited dead bank card . . . a dead deposit card associated with an inactive deposit account comprising a checking account or a savings account”**

According to Claim 1, the issuing bank will distribute an “unsolicited dead bank card . . . [that is] a dead deposit card associated with an inactive deposit account comprising a checking account or savings account.”

**Melchione**

In the latest Office Action, the Office Action admits that the primary reference Melchione fails to teach distributing (a) a **dead bank card [dead deposit card]**, that is (b) **unsolicited by the recipient**, and that is (c) associated with an **inactive deposit account**. See Office Action at 3 (Melchione “do[es] not teach creating an unsolicited dead bank card comprising a dead deposit card”); at 4 (Melchione “do[es] not teach a dead bank card associated with an inactive bank account, and distributing the dead bank to the person”); at 5 (Melchione “do[es] not teach issuing [a] dead bank card associated with [a] deposit account”); at 9 (Melchione “do[es] not teach distributing an *unsolicited* dead bank card associated with an *inactive bank account* to the customer . . .”) [emphasis in original].

Because Melchione fails to teach these three separate claim elements, the Examiner turns to four other references (Walker, Richard, Jones, and Nabe) to address the deficiencies of the primary reference.

**Other References: Walker**

Starting with Walker, the Office Action asserts that Walker teaches distribution of a dead bank card that is unsolicited. Office Action at 9. Walker teaches the offer of an a preapproved unsolicited credit card by a sponsoring organization (e.g., casino) based on the expected arrival



time of a consumer at the sponsor's location (checking in at the casino). Walker, Abstract; Figs. 5A-5C. Walker, considered alone or in combination with Melchione, does not teach or suggest, creating unsolicited dead deposit bank cards associated with an inactive deposit account and distributing those dead deposit bank cards. Rather, Walker teaches in-person distribution of unsolicited credit cards associated with a credit card account.

In attempting to read Claim 1 on Walker, the Examiner disregards the limitation of Claim 1 that the claimed subject matter is directed to "dead bank cards"/"dead deposit cards" and "inactive deposit accounts comprising a checking account or savings account." A credit card account is not a deposit account, is not a checking account or savings account, and they are not treated the same in the financial services industry. To emphasize the distinction, Applicant has amended the claim to provide that the claimed dead bank card is a "deposit account card" (e.g., a debit card) and that the inactive deposit account is a "checking account or savings account", which obviously does not encompass the credit card account of Walker. Ironically, the newly-cited Richards reference emphasizes that credit cards and deposit cards like debit cards are treated very differently in the banking industry. In complaining about an unsolicited debit card he received, consumer advocate Bob Richards noted:

"Unlike a credit card, a debit or check card allows you to instantly withdraw money from a checking or savings account. We now were wondering, of course, what might have happened had we simply thrown the envelope with the debit card in the trash without first bothering to cut it up. . . . The infuriating part of this is that it forces us as consumers . . . to shred or otherwise destroy it [debit card], in order to prevent a thief from emptying our check or savings account."

Richards, full text, page 1. Therefore, Richards confirms that credit cards and debit cards are not interchangeable, and thus, Walker's unsolicited credit card does not teach or fairly suggest distribution of unsolicited deposit account cards.

**Other References: Richards**

The Examiner tries to make up the deficiencies of Melchione and Walker by citing the Richards as teaching the issuance to customers of preapproved unsolicited debit cards which need to be accepted and activated. Office Action at 10. The Richards article discloses a consumer advocate's complaint about an unsolicited debit card being improperly sent for an existing, active deposit account. Richards is very distinguishable from the claimed "unsolicited dead bank card . . . [that is] a dead deposit card associated with an inactive deposit account".

First, contrary to the Examiner's assertion, the unsolicited debit card of Richards was already active on arrival:

"[W]ithout following the activation procedure, we went to a grocery store automated teller machine (ATM), swiped the card and entered the PIN number. That was all that was required to obtain a 'quick' \$20. The printed receipt also disclosed the remaining balance in that [preexisting] account. . . . Several days later, my wife made a department store purchase and offered the card as payment . . . The clerk swiped my card through the machine, the receipt was printed, she signed it, and the transaction was accepted . . ."

Richards, full text, page 1. Thus, Richards does not teach an inactive, dead deposit card. On the contrary, Richard's deposit card (debit card) was active—that was one reason for his alarm and complaint.

Second, contrary to the Examiner's assertion, the unsolicited debit card of Richards was not associated with an inactive deposit account, as claimed. On the contrary, the debit card in Richards was associated with a preexisting active deposit account. This was another reason for Mr. Richard's alarm:

"[W]ithout following the activation procedure, we went to a grocery store automated teller machine (ATM), swiped the card and entered the PIN number. That was all that was required to obtain a 'quick' \$20. **The printed receipt also disclosed the remaining balance in that account.** . . .

Richards, full text, page 1. Thus, Richards does not teach distribution of a card associated with an inactive deposit account. On the contrary, Richard's deposit card (debit card) was associated with his active deposit account at the time the card was received.

Finally, Richards actually teaches away from the claimed feature of distribution of an "unsolicited dead bank card . . . [that is] a dead deposit card associated with an inactive deposit account comprising a checking account or savings account." First, Richards' article is generally a siren call against the distribution of unsolicited debit cards. Richards ("Beware the Arrival ...). Second, the issuing bank M&I stated that the unsolicited bank card **had been sent in "error"**, and that the **problem had "been corrected"** so that it would not happen again. Richards, full text, page 1. Thus, while Richards disclosed an incident of an unsolicited debit card being sent, it was done in error and was criticized as improper by both the card recipient and the issuing bank. Under those facts, Richards plainly teaches away from the claimed feature. *KSR Intern. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1740 (2007). See also M.P.E.P. § 2141.02(I)(6) ("A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention", citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). A disclosure teaches away where it criticizes, discredits, or otherwise discourages the solution claimed. *See In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). That is precisely what Richards does.

#### **Other References: Jones**

The Examiner cites Jones as teaching a dead debit card to cure the deficiencies of Melchione, Walker, and Richards. Jones teaches a solicited "dual card" having a private label

credit card (PLCC) account for the “homebrand” merchant and a general-use bank credit card account for other merchants. Jones, Abstract; Fig. 2B; par. [0027] (“The dual card includes features of both a private label card and a credit card”). The dual card allows purchase transactions to be run on either (1) the closed-loop processing network (private label network) when shopping at the homebrand merchant, thus saving the merchant transaction fees, or (2) when shopping at other merchants, the purchase transactions can be run on the open-loop processing network (interchange like VISA or MasterCard). Jones at par. [0022]. As with Melchione, the system in Jones must receive permission from a consumer before sending the card—i.e., **the dual card is not unsolicited, rather, it is requested.** See, e.g., Jones at par. [0027] (“[A] dual card is issued to a consumer upon receipt of an application . . .”). Thus, Jones fails to cure the deficiencies of Richards, Walker, and Melchione by failing to teach distribution of an unsolicited dead bank deposit card, as recited.

The Examiner cites to Jones at pars. [0023], [0050], [0055], and [0059] as teaching distribution of dead cards. Office Action at 10. None of these passages teaches or suggests the claim feature at issue of distributing an “unsolicited dead bank card . . . [that is] a dead deposit card associated with an inactive deposit account comprising a checking account or savings account.” Par. [0023] of Jones simply defines “bankcard” as referring to “credit, debit, or charge card.” Par. [0050] describes that a dual card can be presented at a non-homebrand merchant and run over the interchange network for approval. Par. [0059] describes how a PLCC private label account holder may be upgraded to a dual card “if the consumer has accepted the invitation (or, has failed to opt out within the opt out period)”. None of these passages teaches the unsolicited dead deposit card of the present invention, and the last passage (par. [0059]) emphasizes that the dual card is not unsolicited—instead, it is requested.

**Other References: Nabe**

The Examiner cites to Nabe in order to compensate for the deficiencies of Jones, Richards, Walker, and Melchione. Specifically, the Examiner cites Nabe as teaching selling to an inactive customer. Office Action at 11. Nabe is generally directed to a customer lead generating system for dealers selling products like replacement auto loans. Nabe, Abstract; Fig. 3. Nabe uses a database of Inactive Auto Finance Customers to find possible leads for a potential financier of a new car. Nabe, Fig. 4; par. [0028], par. [0037]. Using various marketing models (e.g., direct response model), Nabe selects a subset of former customers likely to purchase a direct loan for a car. Thus, Nabe is only directed to credit/loan accounts, not deposit accounts, and Nabe does not teach or suggest distribution of dead cards (or any other cards) of any type. In the final analysis, Nabe does not remotely teach or suggest distributing an “unsolicited dead bank card . . . [that is] a dead deposit card associated with an inactive deposit account comprising a checking account or savings account.” Thus, the Examiner does not seem to be considering the claimed invention as a whole but rather appears to be treating the claim as merely a laundry list of limitations. *See* M.P.E.P. § 2141.02(I).

**3. “Distributing the dead bank card from the issuing bank to the person”**

Applicant has amended the independent claims to reflect that the dead bank card is distributed “from the issuing bank to the person/recipient”. As discussed above in Section III.A.2, Walker at best teaches the delivery of unsolicited credit cards to consumers, not unsolicited dead bank cards (dead deposit cards). A further distinction over Walker is that it does not disclose distributing those cards from the issuing bank to the consumer. Instead,

Walker teaches that the sponsoring organization (casino) must distribute the card in person to the recipient. Walker, Fig. 5A (“Upon Arrival, Offer Credit Card to Customer”); par. [0017] (“initiating an offer of the credit card to the customer while the customer while the customer is at the remote location”); par. [0032] (“a plastic credit card is shipped to the hotel, and the hotel offers the card to the customer upon check-in, or otherwise during the customer’s stay at the hotel”). Walker takes the approach of having the sponsoring organization—not the issuing bank—distribute the cards to the customer because of Walker’s focus on reducing the number of credit cards sent by banks to consumers that are never activated. Walker, par. [0008] (“A significant portion of newly issued cards never get activated”). Despite that goal, this indirect, cumbersome approach to distributing the cards means that they are not distributed by the issuing bank to the recipient, as claimed, and moreover, it has the disadvantage that if the customers never arrive in person at the sponsor’s site then the cards will never reach the recipients.

**4. Independent Claim 17 and Dependent Claims 2-16, 18-22, 24-26 and 41 Are Patentable for the same reasons as Claim 1**

Independent Claim 17 recites similar features to those of Claim 1 that distinguish it from the asserted art in Sections III.A.2 and III.A.3 above. Accordingly, Applicant requests that the Examiner withdraw the rejection of Claim 17, as well as dependent Claims 2-16, 18-22, 24-26, and 41, each of which depends directly or indirectly from either Claim 1 or Claim 17.

**5. Dependent Claims 2 and 19 Are Separately Patentable over the Five-Part Combination**

Dependent Claim 2 provides that “the pool [of potential new bank account holders] is identified based on the region or regions served by the bank issuing the new bank accounts.” Dependent Claim 19 provides that whether a “customer is eligible comprises determining

whether the customer resides within the bank account service footprint of the bank.” The Office Action concedes that “Melchione . . . doe[es] not teach the pool is identified based on the region or regions served by the bank issuing the new bank accounts”. Office Action at 5. The Office Action contents this missing feature is provided by Walker at par. [0032]. However, that passage merely states that “when a customer makes a reservation at a hotel, the hotel requests a credit card on the customer’s behalf. If the issuing bank approves a credit line, a plastic credit card is shipped to the hotel, and the hotel offers the card to the customer upon check-in.” That passage does not remotely teach creating a pool “based on the region or regions served by the bank issuing the new bank accounts”. If there is a pool in Walker, it is the pool of guests checking into the casino, not a pool for the region that the bank serves.

In the case of Claim 19, the Office Action asserts that Melchione discloses “determining whether the customer resides within the bank account service footprint of the bank” at Fig. 6C, Col. 35, lines 49-57. Office Action at 11. However, Figure 6C of Melchione merely shows a customer profile screen at a workstation. Melchione at Col. 35, lines 49-57 discloses that the household account summary screen of Fig. 6C shows “accounts and other information for all members of a selected household . . . [as well as other ] information about the customer (e.g., homeowner, children, competitor, business address change, etc.). These passages do not remotely teach or suggest “determining whether the customer resides within the bank account service footprint of the bank”.

Applicant respectfully requests that the rejection of Claims 2 and 19 be withdrawn.

**6. Dependent Claim 3 is Separately Patentable over the Five-Part Combination**

Dependent Claim 3 provides that the “pool is identified based on individuals applying for a new credit account.” The Office Action asserts that Melchione teaches this feature at Fig 10B. Office Action at 6. However, Figure 10B is a flow diagram of a method for “opening an account with an existing customer in the integrated financial system.” Melchione at Col. 13, lines 30-34. Figure 10B is described as a generic “Account Opening System and Servicing Process” and it does not appear that the description of Figure 10B beginning at Col. 43, line 30 includes disclosure of a “pool [of potential new bank account holders] being identified based on individuals applying for a new credit account”, as claimed. The passage on Figure 10B is lengthy and jumps between various figures, so Applicant invites (and requests) that the Examiner provide a pin-point cite to where the Examiner contends Melchione teaches Claim 3.

**7. Dependent Claims 9 and 21 are Separately Patentable over the Five-Part Combination**

Dependent Claim 9 provides for “determining whether the person was a previous bank account holder.” Dependent Claim 21 has similar language. The Office Action contends this feature is taught by Melchione in Figure 10A. Office Action at 7 (referencing block 200 “Review Profiles Prepare for Session”). Figure 10A is described as a method for “opening an account with a new customer in the integrated financial system”. Melchione, Col. 13, lines 26-30. The Review Profiles block that the Examiner appears to be referencing is described as follows:

“REVIEW PROFILE SYSTEM AND STEP (200). Before meeting with the customer, the user (personal banker) should review the customer profile to prepare for the sales conversation. The system preferably includes a general purpose computer and/or networked work stations for this purpose. The computers or workstations should, of course, include some type of display. The



principal objective of the profile review is to prepare for a sales session with the customer. Again, where legal and appropriate, additional information obtained from the central database, for example, could be used during this step.”

Col. 45, lines 20-31. Applicant cannot discern how that passage or the other description of Figure 10A beginning at Col. 43, line 30 discloses “determining whether a person was a previous bank account holder”, as claimed. The passage on Figure 10A is lengthy and jumps between various figures, so Applicant invites (and requests) that the Examiner provide a pin-point cite to where the Office Action contends Melchione teaches Claims 9 and 21.

#### **8. Dependent Claims 10 and 22 are Separately Patentable over the Five-Part Combination**

Dependent Claim 10 provides for “determining why the person closed the previous bank account in the event the person [from the pool of potential new bank account holders] was a previous bank account holder.” Dependent Claim 22 has similar language. The Office Action contends this feature is disclosed by Melchione in Figure 10A and its steps 200 and 300. Office Action at 7. The passage for Melchione’s step 200 (set forth immediately above in Section III.A.8 does not disclose the claimed feature. Melchione’s describes the following for the “Address Immediate Needs” block 300:

“ADDRESS IMMEDIATE NEEDS SYSTEM AND STEP (300) Customers sometimes come into contact with consumer banks for a very specific and simple reason that can be handled quickly and does not require close personal assistance. Examples include purchasing a certificate of deposit or U.S. Savings Bond. In such cases, the customer should be serviced as soon as possible. The system permits this by prompting the user to determine if the customer is interested in a simple transaction that can and should be handled immediately. For this step, the system includes a programmed general purpose computer or workstation with a display or other device for prompting the user.” Col. 45, lines 32-44.

Applicant cannot discern how that passage or the other description of Figure 10A beginning at Col. 43, line 30 discloses “determining why the person closed the previous bank account in the

event the person [from the pool of potential new bank account holders] was a previous bank account holder”, as claimed. The passage on Figure 10A is lengthy and jumps between various figures, so Applicant invites (and requests) that the Examiner provide a pin-point cite to where the Office Action contends Melchione teaches Claims 10 and 22.

**9. Dependent Claim 12 is Separately Patentable over the Five-Part Combination**

Dependent Claim 12 provides “determining whether the person is eligible [for opening a new bank account] comprises determining whether the person is an existing or past credit card account holder with the bank and evaluating the payment history if the person is an existing or past credit account holder.” The Office Action contends this limitation is disclosed by Melchione in Figures 10A and 10B. See Office Action at 7. Applicant has reviewed Figures 10A and 10B and cannot find this feature. Applicant cannot discern how Figures 10A/B or the description of those figures beginning at Col. 43, line 30 discloses “determining whether the person is eligible [for opening a new bank account] comprises determining whether the person is an existing or past credit card account holder with the bank and evaluating the payment history if the person is an existing or past credit account holder”, as claimed. The passages on Figures 10A/B are lengthy and jump between various figures, so Applicant invites (and requests) that the Examiner provide a pin-point cite to where the Examiner contends Melchione teaches Claims 12.

**10. Dependent Claim 14 is Separately Patentable over the Five-Part Combination**

Dependent Claim 14 provides for “prebuilding an account if the person is determined to be eligible [for opening a new bank account], thereby permitting the bank to implement the new bank account quickly upon acceptance of the offer by the person”. The Office Action contends

this feature is disclosed in Melchione at Col. 7, lines 59-67; Col. 8, lines 1-7; and Col. 9, lines 53-64. Office Action at 8. Those passages disclose the following:

“In the preferred embodiment, the central database stores, in one location, information from various businesses and markets within the financial institution. The central database may include information concerning existing customer financial information, information from outside sources, and demographic information about existing and potential customers. In the preferred embodiment, the central database is housed in a mainframe computer and includes a large repository of financial and demographic data. Information is fed into the database from a variety of sources, including business and credit card feeds from the financial institution for each product and service offered by the institution, and feeds from outside vendors. The outside vendor feeds preferably include all publicly available demographic information, phone numbers, addresses, tax and property records, and so forth.”

\* \* \*

“The personal bankers receive access to the list of leads on the CCIS workstation, after the list is generated by the micromarketing center and communicated to the CCIS. The personal bankers then conduct sales sessions (e.g., telephone calls) with each of the customers on the list of leads. Before and during the sales sessions, the personal bankers use the CCIS to view a complete profile (in detail or in summary form) of the customer's relationship with the bank and any other demographic information about the customer contained on the central database. This allows the personal banker to speak intelligently with the customer during the sales session and thereby increase the success rate of the marketing campaign.”

Col. 7, line 59-Col. 8, line 7; Col. 9, lines 53-64. Applicant respectfully submits that neither of those passages remotely teaches or suggests “prebuilding an account if the person is determined to be eligible [for opening a new bank account], thereby permitting the bank to implement the new bank account quickly upon acceptance of the offer by the person”, as claimed.

**11. Dependent Claim 23 is Separately Patentable over the Six-Part Combination that adds Strock**

Claim 23 provides for “a first incentive being provided to a customer who is not an existing bank account holder and who is not a past bank account holder, and a second incentive being provided to a customer who is not an existing bank account holder and who is a past bank

account holder, thereby providing different incentives to new bank account customers and past bank account customers.”

The Examiner admits that Melchione does not disclose the additional limitation of Claim 23. See Office Action at 14. In order to close the gap, the Examiner adds Strock, U.S. Pub. No. 2004/0122736 to the combination. The Office Action asserts that Strock teaches the limitation of Claim 23 at Figure 3B and par. [0010]. Strock generally discloses methods for granting promotional awards to credit card account holders if the customer accomplishes the promotional reward-earning behavior within the promotional time frame. Strock, Abstract.

Applicant cannot discern how Figure 3B of Strock discloses the limitation of Claim 23. Paragraph [0010] of Strock states the following:

[0010] Further, the universe of reward-earning behaviors for such rewards programs is limited. Rewards are typically earned by charging more transactions on a credit card account. Special rewards also may be earned by purchasing from a particular Bank partner ("Partner"). Finally, rewards can be earned by accomplishing certain tasks or exhibiting certain behaviors, such as by opening a bank account. However, prior art reward systems typically cannot differentiate transactions (or other reward-earning behaviors beyond these limited criteria of dollar amount and merchant.

Applicant respectfully submits that the above passage of Strock does not remotely teach or suggest “a first incentive being provided to a customer who is not an existing bank account holder and who is not a past bank account holder, and a second incentive being provided to a customer who is not an existing bank account holder and who is a past bank account holder, thereby providing different incentives to new bank account customers and past bank account customers”, as claimed.

## **12. Dependent Claim 24 is Separately Patentable over the Combination**

Claim 24 provides that a “live credit card and dead bank card [dead deposit card] are communicated to the customer in a single mailing.” The Office Action asserts this feature is disclosed in Melchione at Figure 16A and Columns 18-29, “where the bank issues different credit cards (secured and unsecured), mailing of which can be together or separately.” Office Action at 12.

Applicant respectfully disagrees. The claim provides that a live credit card and dead deposit card are sent in a single mailing. That is different from sending a secured credit card and an unsecured credit card. Moreover, Figure 16A does not appear to even disclose sending a secured credit card and unsecured credit card. If the Examiner believes that Melchione discloses the claimed feature of sending a “live credit card and dead bank card [dead deposit card] . . . in a single mailing”, a pin-point citation within cited Columns 18-29 is requested.

**B. Claims 27-32 Are Patentable Over the Four-Part Combination of Jones + Walker + Richards + Nabe**

Claims 27-32 stand rejected under 35 U.S.C. § 103 as rendered obvious by the 4-part combination of:

- (1) Walker (US Pub. No. 2008/0052225), in view of
- (2) Richards, B., “Beware the Arrival of Unsolicited Debit Cards” (Madison Capital Times: 2000), further in view of
- (3) Jones (US Pub. No. 2004/0117300), and further in view of
- (4) Nabe (US Patent No. 7,305,364).

Office Action at 15. Applicant respectfully submits that these references, whether considered individually or in combination, do not render the claimed invention obvious.

**1. If the Five-Party Combination is Deficient, Surely the Four-Part Subcombination is Deficient**

Claims 27-32 recite some of the same features as those in Claims 1 and 17 used to distinguish the 5-part combination of Melchione + Walker + Richards + Jones + Nabe. If the 5-part combination is deficient, then surely the 4-part subcombination of Jones + Walker + Richards + Nabe is deficient.

Claims 27-32 are patentable over Jones + Walker + Richards + Nabe for at least the same reasons set forth above in Section III.A for Claim 17 distinguishing

**2. Claims 27-32 are Patentable over the Four-Part Combination**

Claims 27-32 stand rejected as allegedly rendered obvious by Jones in view of Walker, further in view of Richards, and further in view of Nabe. Office Action at 15. Applicant respectfully traverses this rejection of the claims as amended.

Claim 27 recites “determining . . . if the customer is an existing bank deposit account holder with the bank”. The Office Action contends this limitation is disclosed in Jones at Fig. 5A, step 206. Office Action at 15. Figure 5A is a “flow chart[] for activating dual cards”, which are dual-account cards having a private label credit card [PLCC] and a general-use credit card. Jones at [0020]. Step 206 is a decision block for activating a dual card that asks whether the activating customer is an “Existing DualCard Customer or New Customer”. Figure 5A, step 206. An existing customer in Jones means an existing credit card customer, not an existing “bank deposit account holder”, as claimed.

Jones was distinguished above in Section III.A.2 for not teaching or suggesting an ““unsolicited dead bank card . . . [that is] a dead deposit card associated with an inactive deposit

account comprising a checking account or savings account.” Claim 27 recites a similar feature and is distinguishable over Jones for the same reasons as before.

The Examiner does admit that Jones fails to teach that element, but asserts that Walker supplies this feature. Office Action at 16. However, Walker’s unsolicited credit card does not teach or fairly suggest distribution of unsolicited deposit account cards, as discussed in detail above in Section III.A.2 for Claim 1.

The Office action acknowledges that Walker is directed to unsolicited credit cards, not unsolicited deposit account cards. Office Action 16-17. The Examiner points to Richards to cure this deficiency of Walker. However, Richards does not teach or suggest an unsolicited debit card associated with an inactive bank deposit account. On the contrary, the debit card in Richards was associated with a preexisting active deposit account. Richards is very distinguishable for the reasons set forth in Section III.A.2 and, in fact, affirmatively teaches away from the claimed invention.

Nabe’s system for marketing auto loans to an inactive customer base is distinguishable for the reasons set forth above for Claim 1 in Section III.A.2.

Dependent Claims 28-32 are patentable for at least the same reasons as Claim 27.

## **2. Claims 33-36**

Claims 33 – 36 stand rejected as allegedly rendered obvious by Jones + Walker + Richards + Nabe and further in view of Strock. Office Action at 19. Applicant respectfully traverses this rejection.

For the reasons noted above, Claims 33-36 are patentable for at least the same reasons as independent Claim 27. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of these claims.

### **III. CONCLUSION**

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

Should the Examiner believe anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below.

Dated: June 27, 2011

Respectfully submitted,

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